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10/767,669

01/29/2004

Heinrich Lang

LMX-129 CON

5424

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02/04/2005

McNair Law Firm, P.A.

P.O. Box 10827

Greenville, SC 29603-0827

EXAMINER

SHAFFER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/767,669

Applicant(s)

LANG ET AL

Examiner

Ricky D. Shafer

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 and 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Newly submitted claims 13-15 and 17-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly submitted claims 13-15 and 17-23 are not readable on the elected invention because the newly submitted claims fail to include the details of a housing, a framing element having a first recess, a holding tube, a clamping part having a second recess and a snap connection (see original claim 10) nor a positioning apparatus affixed to the carrier plate opposite the mirror pane and secured to the framing, a bracket releasably clamped to the framing, a first holding arm clampingly disposed between the upper strip and the framing and a second holding arm clampingly disposed between the lower strip and the framing (see original claim 11). Furthermore, newly submitted claims 13-15 and 17-23, particularly claim 17, adds various aspects of the framing having a configured area to engage with the holding arm, the bracket having a configured area spaced from the upper and lower strips to engage with the holding arm and a plurality of connectors to engage with the positioning apparatus which would require a search in class 403, subclass 376 which would not be required for the elected invention.

The elected and newly submitted inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable. In the instant case, each of the elected and the newly submitted inventions has separate utility such as a rearview mirror assembly with the separate details of the other invention. For example, the rearview mirror assembly of the elected invention has separate utility as a rearview mirror assembly without the framing having a configured area

Art Unit: 2872

to engage with the holding arm, the bracket having a configured area spaced from the upper and lower strips to engage with the holding arm and a plurality of connectors to engage with the positioning apparatus of the newly submitted invention and the newly submitted invention has separate utility as a rearview mirror assembly without a housing, a framing element having a first recess, a holding tube, a clamping part having a second recess and a snap connection (note original claim 10) nor a positioning apparatus affixed to the carrier plate opposite the mirror pane and secured to the framing, a bracket releasably clamped to the framing, a first holding arm clampingly disposed between the upper strip and the framing and a second holding arm clampingly disposed between the lower strip and the framing (note original claim 11).

See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-15 and 17-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The terminal disclaimer filed on 11/17/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/800,114 has been reviewed and is NOT accepted.

Accordingly, the double patenting rejection set forth in the previous office action is maintained.

The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee.

See MPEP § 324.

Art Unit: 2872

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34

(a). See 37 CFR 1.321(b) and/or (c).

It would be acceptable for a person, other than a recognized officer, to sign a terminal disclaimer, provided the record for the application includes a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the organization.

Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

It should be noted that applicant is not required to pay another disclaimer fee as set forth in 37 CFR 1.20(d) when submitting a replacement or supplemental terminal disclaimer.

3. The drawing received on November 17, 2004 is not acceptable. The drawing is not in compliance with 37 CFR 1.121(d) because applicant failed to label the drawing as a "Replacement Sheet".

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2872

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/800,114, now U.S. Patent 6,830,352. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application discloses no additional invention or discovery other than what was already claimed and allowed in application (09/800,114), now U.S. Patent 6,830,352 or what would have been obvious to one of ordinary skill in the art at the time the invention was made. Moreover, the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in copending Application No. 09/800,114, now U.S. Patent 6,830,352, and is covered by the patent since the patent and the present application are claiming common subject matter, as follows: a rearview mirror assembly for attachment to a vehicle via a holding tube, the assembly comprising a housing (5) including a framing element (4) configured to attach to the holding tube (10); and a clamping part (12) configured to attach to the holding tube disposed opposite of the framing element, the framing element and the clamping part cooperating to clamp about the holding tube

Art Unit: 2872

and releasably attach to each other, the clamping part further configured to fastenably hold a mirror element (6), wherein the clamping part has a hook element (16) and the framing element has a snap connection, the hook element and the snap connection snap-connectable to secure the framing element and the clamping part together; wherein the framing element defines a first recess and the clamping part defines a second recess, the first and second recess configured to encase the holding tube. Note Fig. 2.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2872

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

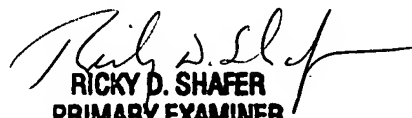
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

February 02, 2005

  
RICKY D. SHAFER  
PRIMARY EXAMINER  
GROUP 2500  
ART UNIT 2872